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| 09/843,197      | 04/26/2001  | Patrick Chiu         | FXPL1024US0         | 8826             |

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| EXAMINER |
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HUYNH, CONG LAC T

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| ART UNIT | PAPER NUMBER |
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2178

DATE MAILED: 09/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/843,197

Applicant(s)

CHIU ET AL.

Examiner

Cong-Lac Huynh

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4,8 and 10-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,8,10-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to communications: amendment filed 5/2/06 to the application filed on 4/26/01.
2. Claims 21-25 are added.
3. Claims 1, 4, 8, 10-25 are pending in the case. Claims 1 and 15 are independent claims.

### ***Response to Amendments***

4. The declaration filed on 5/2/06 under 37 CFR 1.131 has been considered but is ineffective to overcome the Stifelman reference.
5. Following the interview on 8/8/06, the objection of the declaration regarding the one year gap from March 2000 to March 2001 has been withdrawn since it is not in the critical time period. This action, thus, is made non-final.
6. However, two things remain in question. First, is it proper to file both reducing to practice and conception coupled to due diligence in a declaration? Second, whether the conception as filed in the declaration is sufficient.
7. After consulting with the SPRE, the declaration submitted on 5/2/06 has been considered. However, Applicant is not recommended to file such a declaration in the future because of potential confusing when both reduction to practice and conception are claimed in the same declaration.
8. Regarding the second question, there is a gap from 3/27/01 to 4/10/01 during the critical time to prove due diligence. Such gap of almost two weeks is not allowed without any acceptable excuses. MPEP 2138.06 states:

*An applicant must account for the entire period during which diligence is required. Gould v. Schawlow, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); In re Harry, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. In re Mulder, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); Fitzgerald v. Arbib, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); Kendall v. Searles, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts.). The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. Rebstock v. Flouret, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); Rieser v. Williams, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958) (Being last to reduce to practice, party cannot prevail unless he has shown that he was first to conceive and that he exercised reasonable diligence during the critical period from just prior to opponent's entry into the field); Griffith v. Kanamaru, 816 F.2d 624, 2 USPQ2d 1361 (Fed. Cir. 1987) (Court generally reviewed cases on excuses for inactivity including vacation extended by ill health and daily job demands, and held lack of university funding and personnel are not acceptable*

*excuses.); Litchfield v. Eigen, 535 F.2d 72, 190 USPQ 113 (CCPA 1976) (budgetary limits and availability of animals for testing not sufficiently described); Morway v. Bondi, 203 F.2d 741, 749, 97 USPQ 318, 323 (CCPA 1953) (voluntarily laying aside inventive concept in pursuit of other projects is generally not an acceptable excuse although there may be circumstances creating exceptions); Anderson v. Crowther, 152 USPQ 504, 512 (Bd. Pat. Inter. 1965) (preparation of routine periodic reports covering all accomplishments of the laboratory insufficient to show diligence); Wu v. Jucker, 167 USPQ 467, 472-73 (Bd. Pat. Inter. 1968) (applicant improperly allowed test data sheets to accumulate to a sufficient amount to justify interfering with equipment then in use on another project); Tucker v. Natta, 171 USPQ 494,498 (Bd. Pat. Inter. 1971) (“[a]ctivity directed toward the reduction to practice of a genus does not establish, prima facie, diligence toward the reduction to practice of a species embraced by said genus”); Justus v. Appenzeller, 177 USPQ 332, 340-1 (Bd. Pat. Inter. 1971) (Although it is possible that patentee could have reduced the invention to practice in a shorter time by relying on stock items rather than by designing a particular piece of hardware, patentee exercised reasonable diligence to secure the required hardware to actually reduce the invention to practice. “[I]n deciding the question of diligence it is immaterial that the inventor may not have taken the expeditious course....”).*

The Stifelman reference, therefore, is still applied.

***Claim Objections***

9. Claim 25, which is dependent on claim 8, is objected to since the claimed limitation is merely a repetition of the limitations of claim 8. Claim 25, thus, appears redundant.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1, 4, 11-12, 14-24 remain rejected under 35 U.S.C. 102(e) as being anticipated by Stifelman et al., The Audio Notebook, Paper and Pen Interaction with Structured Speech, SIGCHI'S 01, March 31-April 4, 2001, vol. 3, Iss. 1, ACM 2001, pages 182-189.

Regarding independent claim 1, Stifelman discloses:

- receiving a notation from a notetaking user during a meeting (**page 182, Abstract, Introduction, page 183, Audio Notebook Version 1: synchronizing user's handwritten notes during a meeting with a digital audio recording and indexing the written notes and audio indicate receiving notes from a user during a meeting**)

- automatically recording an index value for the notation, the index value based on the context of the notation (**page 182, Introduction:** “The Audio Notebook *synchronizes the user’s handwritten notes with a digital audio recording*. The user’s natural activity – writing and page turns – *implicitly indexes the audio* for later retrieval ...”; **page 183, Prior Work in Indexing Audio :** “The AIR project (Activity-based Information Retrieval) proposed employing user activity (e.g. *notetaking*, writing on whiteboards, user location) *to index multimedia data ...* Audio Notebooks *links audio recording to notes taken on paper* and provides several techniques to access the audio ... Dynamite *indexes audio with notetaking activity* on a pen-based computer. Users can manually assign keywords to pages of notes ... *the audio and video are indexed by all notes written on, or beamed to, the LiveBoard*, and by page changes on the LiveBoard”) )
- receiving a quantity of multimedia information from at least one multimedia source (**page 183, Prior Work in Indexing Audio:** the fact that the multimedia data as *audio and video are indexed by all notes written*, implies that a quantity of multimedia information from at least one multimedia source, audio source and video source, is received)
- automatically selecting at least one portion of the quantity of the multimedia information based on the index value of the notation (**page 183, Prior Work in Indexing Audio:** “The audio and video are indexed by all notes written on, or beamed to, the LiveBoard, and by page changes on the LiveBoard ...”; **page**

**183, Audio Notebook Version 1:** “An early version of the Audio Notebook [7] demonstrated the basic concept of linking notes on paper with an audio recording. This early prototype showed the concept of automatic page number detection, and selecting on the page to begin audio playback (Fig. 1) ... *Playback begins at the point in the audio recording that corresponds to when the note was originally written* ... Dragging the pen along an audio scrollbar navigates a timeline of the audio associated with each page ...”; **pages 183-184, Audio Scrollbar with Audio Cursor:** “when a user selects somewhere on a page to begin playback, the audio cursor lights up showing the corresponding location in the timeline .. ”)

- automatically creating an association between the notation and the selected portion of the quantity of multimedia information, where the association enables access to the selected portion of the quantity of multimedia information (**page 182, Introduction** : synchronizing between the user's written notes and the audio recording and indexing the recorded audio based on the user's notetaking for later retrieval of audio show an association between the notation and the correspondent audio where the association enables access to the selected multimedia for retrieval; **page 183, Prior Work in Indexing Audio:** “the Audio Notebook links audio recording to notes taken on paper and provides several techniques to access the audio”, “Classroom 2000 [1] captures audio, video, and slides, and links it to notes taken on tablet computers and electronic whiteboards. Access to the captured material is through an HTML-based web browser”; **page**



- 183, Audio Notebook Version 1:** “An early version of the Audio Notebook [7] demonstrated the basic concept of linking notes on paper with an audio recording. This early prototype showed the concept of automatic page number detection, and selecting on the page to begin audio playback”)
- storing the notation and the association for retrieval at a future time, where the future time is one of a time during the meeting and a time after the meeting
- (**page 182, Introduction** : Synchronizing between the user's written notes and the audio recording and indexing the recorded audio based on the user's notetaking for later retrieval of audio show that the notation and the corresponding audio recorded are stored for later retrieval; **page 183, Audio Notebook Version 1:** playback the recorded audio based on the selected page of the taken notes indicates that the notation taken by a user and the association of the written notes and the recorded audio are stored for retrieval later at a future time; the later retrieval implies that retrieval can occur any time after recording data, and thus further implies that “later” or the future time is one of a time during the meeting and a time after the meeting; **page 183, Audio Notebook Version 1:** the fact that after recording the audio of a lecture or meeting based upon the notetaking by a user, the audio can be accessed by space or by time indicates that retrieving the recorded audio can be made any time, i.e. during the meeting, as long as it occurs after the audio recording; in other words, the future time can be during the meeting)

- wherein a single action by the notetaking user initiates the steps of receiving the notation, recording, selecting, creating and storing (**page 182, Introduction, page 183, Audio Notebook Version 1**: as mentioned above, Stifelman discloses that the user's natural activity, such as writing and page turns, *implicitly indexes the audio* for later retrieval, *the audio and video are indexed by all notes written on, or beamed to, the LiveBoard, and Playback begins at the point in the audio recording that corresponds to when the note was originally written*; the fact that the audio and video are indexed when the note was originally written, linking audio recording to notes taken on paper, and playback the recorded audio based on the selected page of the taken notes inherently indicates that **based on receiving a note written by a user**, the index is recorded corresponding to the selected audio and video where said index recording shows the creation of the association between the taken notes and related multimedia which is stored for playback and retrieval later on; in other words, the notetaking of a user initiates the steps of recording, selecting, creating, and storing)

Regarding claim 4, which is dependent on claim 1, Stifelman discloses that the quantity of multimedia information includes information for accessing a second quantity of multimedia information (page 183, Prior Work in Indexing Audio: the fact that the audio and video are indexed by all notes written on, or beamed to, the LiveBoard indicates that beside the audio, video is the second multimedia information to access while taking notes).

Regarding claim 11, which is dependent on claim 8, Stifelman discloses:

- receiving a quantity of information from a user (page 186, Use of the Audio Recordings: the fact that a student adds information to her notes shows that the information is received from a user)
- revising at least one of the stored notations and its respective association in response to the quantity of information received from the user (**page 186, Use of the Audio Recordings:** *marking* in the notes, *writing something* in the notes, and *adding more details* into the notes by a user are actions to *revise* the stored notations and its respective association in response to the information such as text written to notes or details added to the notes received from a user)

Regarding claim 12, which is dependent on claim 11, Stifelman discloses that the quantity of information received from a user includes a copy of at least a portion of the plurality of notations, where the user has altered at least one of the plurality of notations to indicate the desired revision (**page 186, Review Session:** a user can add a few annotations to a note such as putting star symbols next to important areas or marking things in a note to review where the star symbols or the mark made by a user have altered at least one of the plurality of notes to indicate the desired revision).

Regarding claim 14, which is dependent on claim 13, Stifelman discloses that the quantity of information received from a user includes a copy of at least a portion of the plurality of notations, where the user has altered at least one of the plurality of notations

to indicate the desired revision (**page 186, Review Session:** a user can add a few annotations to a note such as *putting star symbols next to important areas* or *marking things in a note to review* where the star symbols or the mark have altered at least one of the plurality of notes to indicate the desired revision).

Claims 15-16 are for an apparatus of method claim 1, and are rejected under the same rationale.

Claims 17-18 are for an apparatus of method claims 11-12, and are rejected under the same rationale.

Claims 19-20 are for an apparatus of method claims 6-7, and are rejected under the same rationale.

Regarding claim 21, which is dependent on claim 1, Stifelman discloses that the notation is text (page 182: handwritten note is text).

Regarding claim 22, which is dependent on claim 1, Stifelman discloses that the index value indicates a time when the notation is received (page 183: “.. *users must draw lines across a notetaking area to indicates a “time zone.” All notes in a time zone are indexed to single time point in the video...*”).

Regarding claim 23, which is dependent on claim 1, Stifelman discloses using the index value to select a portion of the quantity of multimedia information received at the time the notation was received (page 183: “.. users must draw lines across a notetaking area to indicates a “time zone.” All notes in a time zone are indexed to single time point in the video...”; since the notes received in a time zone are indexed to a single point in the video, this implies that the time zone value can be used to select a portion of video corresponding to the time zone; page 183: “The audio and video are indexed by all notes written on, or beamed to .. “).

Regarding claim 24, which is dependent on claim 1, Stifelman discloses that the association enables access to a slide (page 183: “Classroom 200 [1] captures audio, video, and slides, and links it to notes taken on tablet computers and electronic whiteboards. Access to the captured material is through an HTML-based web browser”).

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claims 8 and 25 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Stifelman as applied to claim 1 above, and further in view of Davis et al., NotePals: Lightweight Note Sharing by the Group, for the Group, ACM 1999, pages 338-345 (IDS submitted by Applicants).

Regarding claims 8 and 25, which are dependent on claims 1 and 25 respectively, Stifelman discloses that the steps of receiving a notation, recording, receiving a quantity of information, selecting, creating, and storing are repeated for a plurality of notations (**page 183, Prior Work in Indexing, Audio Notebook Version 1**: the fact that the audio and video are indexed when the note was originally written, linking audio recording to notes taken on paper, where the note, audio and video data are a quantity of information are received, and playback the recorded audio based on the selected page of the taken notes inherently indicates that ***based on receiving a note written by a user***, the index is **recorded** corresponding to the **selected** audio and video where said index recording shows **the creation of the association** between the taken notes and related multimedia which is **stored** for playback and retrieval later on; **page 183**,

**Prior Work in Indexing Audio:** the fact that the audio and video are *indexed* by all notes written on, or beamed to, the LiveBoard, or capturing audio, video, and slides and linking it to notes taken on tablet computers and electronic whiteboards indicates that the claimed steps are repeated for a plurality of notations).

Stifelman does not disclose transmitting the plurality of notations and their respective association via an electronic network to at least one user for future retrieval by said user.

However, Stifelman does teach the linking of captured multimedia and the notes taken on tablet computers and electronic whiteboards and access to the captured multimedia is through an HTML-based web browser (page 183, Prior Work in Indexing Audio).

Davis discloses the group members in a meeting can retrieve and view the notes taken with browsers (**page 338, abstract**) and automatically capturing notes taken in any context and making those notes and the related documents accessible to an entire workgroup via the web (**page 338, Introduction**).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Davis into Stifelman for the following reason. Davis discloses the ability to *access notes to an entire workgroup via the web and retrieving notes during a meeting using the web browser* providing the advantage to incorporate into accessing the captured multimedia related to the notes taken in Stifelman via the web browser for transmitting the notes and their respective association, which are the related multimedia of the notes, via an electronic network, which is the web, to groups of

users instead of limiting the use of taken notes and related audio and video in a meeting by a user.

15. Claims 10 and 13 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Stifelman and Davis as applied to claims 1 and 9 above, and further in view of Mora et al. (US Pat No. 6,161,113, 12/12/00, 1/20/98, priority 1/21/97).

Regarding claim 10, which is dependent on claim 8, Stifelman and Davis do not disclose that a plurality of the notations and their respective associations are transmitted via an electronic mail message.

Mora discloses sending the meeting minutes to the attendees of the meeting via email (col 14, lines 34-52).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Mora into Stifelman and Davis since Mora can send the meeting minutes to the attendees of the meeting via email providing the advantage to incorporate sending the notes taken and the associated multimedia to users via email since the meeting minutes, which are records during a meeting, thus include also the notes taken during the meeting as in Stifelman and Davis.

Regarding claim 13, which is dependent on claim 8, Stifelman discloses that the quantity of information received from a user includes a copy of at least a portion of the plurality of notations, where the user has altered at least one of the plurality of notations



to indicate the desired revision (**page 186, Review Session**: a user can add a few annotations to a note such as *putting star symbols next to important areas* or *marking things in a note to review* where the star symbols or the mark have altered the at least a portion one of the notes).

Stifelman does not disclose that in step transmitting, the plurality of notations and the respective notations are transmitted as an electronic mail message via an electronic mail network, the electronic mail message containing a predetermined electronic mail address, and in the step of receiving a quantity of information from a user, the quantity of information is received via the predetermined electronic mail address.

Mora discloses sending the meeting minutes to the attendees of the meeting via email (col 14, lines 34-52).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Mora into Stifelman and Davis since Mora can send the meeting minutes to the attendees of the meeting via email providing the advantage to incorporate electronic mail network for sending the notes taken and the associated multimedia since the meeting minutes, which are records of a meeting, thus include also the notes taken during the meeting as in Stifelman and Davis. In addition, the fact that Mora uses the email system for sending meeting minutes to the attendees of the meeting suggests that the information received from a user be via a predetermined electronic mail address since it was well known that sending data via an electronic mail system requires providing a predetermined electronic mail address.

**Conclusion**


16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ichimura (US Pat No. 5,894,306, 4/13/99, filed 7/28/97).

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Thurs (9:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-4125.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
CONG LAC HUYNH  
PRIMARY EXAMINER  
8/30/06